

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Joerg Ehrhardt, *et al.*

Application No.: 09/776,040

Confirmation No.: 2464

Filed: February 1, 2001

Art Unit: 2174

For: SETTING UP A COMMUNICATION  
PROCEDURE BETWEEN INSTANCES AND  
A PROTOCOL TESTER USING THE  
METHOD

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Examiner: Peng Ke

**REPLY BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer dated October 28, 2010 and contains the following items on separate pages, as required by 37 C.F.R. § 41.41 and M.P.E.P. § 1208:

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|------|---|
| I.   | Status of claims                              |
| II.  | Grounds of rejection to be reviewed on appeal |
| III. | Argument                                      |

**I. STATUS OF CLAIMS**

**A. Total Number of Claims in Application**

Claims 1-20 are pending in the application and stand finally rejected under 35 U.S.C. § 103.

**B. Current Status of Claims**

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 1 - 20.
4. Claims allowed: None.
5. Claims rejected: 1 - 20.

**C. Claims On Appeal**

The claims on appeal are claims 1 - 20.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Whether claims 1-3, 5-10, 13, 14, 17, 19 and 20 are unpatentable under 35 U.S.C. § 103(a) as being obvious based on U.S. Patent No. 5,732,213 to Gessel (hereinafter “Gessel”) in view of U.S. Patent No. 5,027,343 to Chan et al. (hereinafter “Chan”); and
- B. Whether claims 4, 11, 12, 15, 16 and 18 are unpatentable under 35 U.S.C. § 103(a) as being obvious based on Gessel in view of Chan in view of U.S. Patent No. 6,560,723 to Matsui (hereinafter “Matsui”).

### III. ARGUMENT

#### A. No claim construction set forth for the pending claims

Appellant's Brief objected to the Office Action dated March 8, 2010 ("Office Action") as failing to construe or define the pending claims and claim limitations. The Appeal Brief further argued that the pending claim limitations were improperly interpreted in the Office Action and, as a result, unrelated prior art features are incorrectly cited against the pending claim limitations. (Appeal Brief at 6).

In particular, independent claims 8 and 20 include limitations written in means-plus-function form. According to 35 U.S.C. § 112, ¶ 6, an element in a claim expressed as a means or step for performing a specified function without the recital of structure "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." The Office Action and the Examiner's Answer both fail to identify either the specified function in these claim limitation or the corresponding structure in the specification. Without first construing these claim limitations under 35 U.S.C. § 112, ¶ 6, the Office Action cannot properly cite references against the pending claims.

#### B. Selecting a protocol layer

Appellant made a number of objections to the purported prior art teachings alleged to be "selecting a protocol layer" as set forth in the Office Action. (Appeal Brief at 8-11).

The Examiner's Answer characterizes Appellant's arguments in the Appeal Brief as "[w]hether the combination of Gessel and Chan teaches 'selecting a protocol layer to be emulated by the protocol tester for testing a specified protocol layer of the item under test?'" (Examiner's Answer at 7). In response, the Examiner's Answer states:

Gessel teaches this limitation because it allows user to select the protocol hardware notes that are tested by the emulating software. (see Gessel; column 8, lines 25-30) By selecting hardware notes, user in fact is selecting different protocol layer because different hardware notes are correlated with different protocol layer test. (see Gessel; column 8, lines 30; For example; selection of Interact socket between OSI stack would only be testing layer 3 of protocol layer; column 5, lines 20-25; selection of TCP Note would only be testing layer 4 of protocol)

(Examiner's Answer at 7).

Appellant notes that this is either a new ground of rejection or a new characterization of the Gessel reference that was not previously alleged. The previous rejections of the claims merely quoted the claim language and cited column and line numbers in Gessel. (See, e.g., Office Action at 3-4). Appellant further notes that the term “protocol hardware nodes” appears to be a typographical error that should read “protocol hardware **nodes**.” Accordingly, it Appellant believes that the Examiner’s statement should read:

Gessel teaches this limitation because it allows user to select the protocol hardware *nodes* that are tested by the emulating software. (see Gessel; column 8, lines 25-30) By selecting hardware *nodes*, user in fact is selecting different protocol layer because different hardware *nodes* are correlated with different protocol layer test.

Appellant traverses this characterization of Gessel. The cited portion of Gessel reads:

as a Protocol Adaptable State Machine (PASM) or a Message Generator Traffic Simulator (MOTS). The protocol simulator 73 enables a user to select either an actual target hardware node or a node emulated by software for the testing of OSI layers 3-7. If a hardware node is selected (for example, the target telecommunication switch 71), a communications manager 74 identifies this selection to a protocol simulation socket adaptation module (protocol simulation adaptor) 75 which then selects the proper protocol simulation software 76 and protocol stack 77 for the hardware node. Messages in UNIX-based TCP/IP protocol are

Gessel teaches selecting either an actual target or a node emulated by software for the testing of OSI layers 3-7. This is not the same as:

selecting a protocol layer to be emulated by the protocol tester for testing a specified protocol layer of the item under test on the basis of the communication procedure, the protocol layer selected from a displayed list of protocol layers that are capable of being emulated by the protocol tester, the list of protocol layers including at least one layer 2 protocol from an OSI (Open Systems Interconnection) reference model;

as required in claim 1, for example. The cited disclosure in Gessel is clearly missing any discussion of “selecting a protocol layer.” Instead, Gessel selects a *node* to be tested across all of OSI layers 3-7.

The Examiner’s Answer further states:

Furthermore, nowhere in the applicant’s specification supports the limitation of selecting “a specific protocol layer.” (see applicant’s

specification) In fact, testing of one specific protocol layer may be impossible because a testing higher protocol layer requires the testing of all its lower protocols. (see Gessel; column 1, lines 40-45) For example, the testing of protocol layer 3 would require the successful testing of protocol layers 1 and 2 because layer 3 is software protocol, and for a software protocol to work, the physical protocols, layer 1 and 2, must function successfully first. (see Gessel; column 1 ,lines 45-70)

(Examiner's Answer at 7-8).

Again, Appellant notes that this argument is new and is first presented in the Examiner's Answer. This argument is irrelevant in that it discusses "a specific protocol layer" which is not the claim language. This argument is also incorrect in that the original application at least in Figures 3-5 and the related description is directed to selecting protocols and layers for testing. Finally, this argument is also irrelevant in that the claim language does not exclude testing, evaluation, or performance of other protocol layers in addition to the layer under test.

**C. Displayed list of protocol layers.**

The Examiner argues that the display of hardware *nodes* is the same as the display of protocol layers. (Examiner's Answer at 8-9, points B) and C)). Appellant traverses this rejection for the reasons discussed above with respect to the selection of the protocol layers. The cited disclosure in Gessel lacks any specific disclosure of protocol layers that are displayed for selection. The listing of hardware nodes, which can process multiple layers, is not a listing of different protocol layers.

**D. Conclusion**

For all the reasons discussed above, the rejections of claims 1-20 should be reversed as the claims relate to patentable inventions that are not rendered obvious by the cited references.

Accordingly, Appellants respectfully request that the rejection of claims 1-20 be reversed and that the case be passed on to issuance.

Respectfully submitted,

December 28, 2010

Date

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